

application, it would constitute prior art under 35 USC 102(e) if published or patented.”

Applicants respectfully traverse this rejection.

First, applicants are at a loss to understand the Examiner’s apparent belief that the rejection is only “provisional” because the cited Chang ‘390 publication is not yet published. It was indeed published, on May 1, 2003, as an inspection of its cover page will reveal.

Second, but far more importantly, the Examiner appears to have overlooked the fact that this application has a U.S. regular utility application filing date of November 20, 2000, some eleven months prior to the provisional application filing date of October 19, 2001, of the Chang ‘390 publication. Thus, it is incorrect to state that the Chang ‘390 publication has an earlier effective filing date than this application. Since this application has an earlier non-provisional U.S. filing date than the earliest effective U.S. filing date to which Chang ‘390 could possibly be entitled, Chang ‘390 is not, and cannot be, prior art to this application under 35 USC 102(e).

Third, if necessary applicants can show that the invention of this application and Chang ‘390 were commonly owned at the time this invention was made, thus eliminating Chang ‘390 as prior art under 35 USC 103(c).

Accordingly, the rejection based on Chang ‘390 should be withdrawn since Chang ‘390 is not prior art.

Claims 1, 3-6, 11-13, 15, 16, 25, 27-30, 35-37 and 39 stand rejected under 35 USC 103(a) as unpatentable over Nagai. This rejection is respectfully traversed.

The Examiner admits that Nagai fails to disclose the optical density or thickness of the second polyolefin resin as claimed by applicants. However, the Examiner contends that it would have been obvious to modify these claimed properties since the “optical density and thickness are optimizable as they directly affect the durability and resiliency of the laminate film. As such they are optimizable.” The Examiner also contends that it would have been obvious to adjust the nitrogen functional groups in the first polyolefin layer, as claimed in claim 3, to control the adhesiveness of the film. Since the Examiner has failed to provide support for these assertions

and is assuming without supporting evidence that persons of ordinary skill in the art would have recognized a need to optimize the claimed properties, this rejection should be withdrawn.

The Federal Circuit has repeatedly held that the PTO cannot rely on its own, unsubstantiated knowledge to remedy deficiencies in the prior art. In order to support this rejection the Examiner has assumed, without evidentiary support, that persons of ordinary skill in the art would have recognized the claimed characteristics as result-effective and would have been motivated to optimize them so as to arrive at the claimed invention. As emphasized by the court in *In re Lee*, 277 F.3d 1338, 1344, 1345, 61 USPQ2d 1430, 1434, 1435 (Fed. Cir. 2002), the Examiner must present specific documented evidence of the knowledge in the art:

... This court explained in *Zurko*, 258 F.3d at 1385, 59 U.S.P.Q.2D (BNA) at 1697, that **"deficiencies of the cited references cannot be remedied by the [PTO's] general conclusions about what is 'basic knowledge' or 'common sense.'" The [PTO's] findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability.** "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See *Allentown Mack*, 522 U.S. at 376 ("Because reasoned decision making demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle . . .").

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... The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. **In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record.** The failure to do so is not consistent with either effective administrative procedure or effective judicial review.

(Emphasis added). Here the Examiner has simply asserted that one of ordinary skill in the art would have adjusted optical density and thickness of a polyolefin layer to affect the durability and resiliency of a laminate film without presenting any objective evidence that it was known to adjust these properties for the stated purpose or that persons of ordinary skill in the art would have been motivated to seek the stated purpose.

Further, Nagai actually teaches against optimizing the optical density in the claimed manner. Applicants claim an opaque metallized film while Nagai describes a transparent metallized film. Nagai's optical density is very low, almost zero, so to say that a person of ordinary skill in the art would have optimized Nagai's very low optical density, essentially transparent films so as to arrive at applicants' high optical density, opaque film would require such a person to defeat the purpose of Nagai's film. As described on page 3, line 28, through page 4, line 18, of this application, the opaque film claimed by applicants can be obtained by using high purity aluminum to produce a coating that is primarily aluminum. In comparison, Nagai injects oxygen into the deposition chamber to produce a transparent metallized coating that is primarily aluminum oxide. (See Nagai, column 8, lines 4-21). The transparent metallized film described in Nagai is designed to have a high optical transmittance. (see Nagai columns 6-7, lines 66-67 and 1-3).

Transmission optical density is a measurement of the amount of light transmitted through the test specimen. The lower the optical density, the more light that is transmitted. A 0% optical density (i.e. a perfectly transparent film) indicates that 100% of the light is transmitted through the film and reflected onto a sensor. Optical density is measured on a logarithmic scale, so an optical density of 2.0 means that only 1% of the incident light is transmitted through the film (very opaque). The claimed film has an optical density above 2.6, which is even more opaque.

Since Nagai describes producing a transparent film, optimizing the optical density according to Nagai would produce a film with a very low optical density, approaching zero, not above 2.6 as claimed.

The Examiner also asserts that it would have been known to adjust the amount of nitrogen functional groups in the first polyolefin layer to control adhesiveness of the film. Again, the Examiner has failed to provide any evidence to support the assertion that one of ordinary skill in the art would have known either to adjust this property or to arrive at the range of nitrogen functional groups claimed by applicants.

Since Nagai does not disclose a film with the claimed optical density and since the Examiner is improperly relying on unsupported assertions to remedy deficiencies in the prior art, the rejection of claims 1, 3-6, 11-13, 15, 16, 25, 27-30, 35-37 and 39 in view of Nagai should be withdrawn.

Claims 14, 17, 18, 38, 41 and 42 stand rejected under 35 USC 103(a) as unpatentable over Nagai in view of Kurokawa. Claims 19, 20, 43 and 44 stand rejected under 35 USC 103(a) as unpatentable over Nagai in view of Kurokawa and further in view of Tanizaki. These rejections are respectfully traversed.

Since Nagai does not provide the teachings for which the Examiner cites it, the rejection of claims 14, 17, 18, 38, 41 and 42 cannot stand because Kurokawa does not remedy the deficiencies of Nagai. Moreover, claims 14 and 17-20 depend from independent claim 3, which claims a first polyolefin layer comprising at least 0.3% nitrogen functional groups and a metal layer having an optical density of at least 2.6. Claims 38 and 41-44 depend from claim 27, which claims a metal layer having an optical density of at least 2.6. As explained above, Nagai teaches away from producing a film with the claimed optical density. The Examiner has likewise failed to provide any evidence that one of ordinary skill in the art would have been motivated to obtain a laminate film with the claimed nitrogen functional groups.

In addition, Kurokawa and Tanizaki, like Nagai, also fail to disclose or suggest the claimed range of nitrogen functional groups and optical density. Accordingly, the rejections of claims 14, 17-20, 38 and 41-44 should be withdrawn.

Claims 24 and 46 stand rejected under 35 USC 103(a) as unpatentable over Nagai in view of Yokoyama and in view of Akao. Once again, this rejection cannot stand because Nagai does not supply the teachings for which the Examiner cites it. Claims 24 and 46 claim a laminate film having a aluminum oxide layer and two aluminum-enriched layers. None of the cited references discloses the three claimed aluminum layers. However, the Examiner states that since Akao describes a single aluminum layer, it would have been obvious to modify the film disclosed in Nagai to have multiple aluminum layers. The Examiner has again provided no evidence to support his assertion that persons of ordinary skill in the art would have been motivated to provide the claimed laminate film that has three aluminum layers, let alone the three aluminum layers with the properties claimed in claims 24 and 46. Applicants again respectfully remind the Examiner that the Federal Circuit in *In re Lee* has made it clear that allegations unsupported by objective evidence cannot remedy deficiencies in the prior art. Since the prior art does not disclose a laminate film with all of the claimed aluminum layers, claims 24 and 46 should be allowed.

In light of the above, early allowance of claims 1-20, 24-44 and 46 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 361752000500.

Respectfully submitted,

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